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LERNER GREENBERG STEMER LLP			BLACKWELL, GWENDOLYN A	
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1775
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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/036,178

Applicant(s)

DIMONE, DERRICK J.

Examiner

Gwendolyn Blackwell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

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DETAILED ACTION

1. Based upon the paper dated August 9, 2005, prosecution in the presently pending application has been reopened with the previous rejections set forth in the Examiner's Answer dated February 26, 2004 mooted. Claims 1-5 and 7-14 are currently pending and examined on the merits.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-5 and 7-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The insignia is not limited to an insignia of an automobile. Applicant's originally filed application was drawn to a filler for an automobile insignia. Applicant's amendment of claim 1, dated March 3, 2003, deleted "automobile" which broadened the claim to include any insignia, not just an automobile insignia. Applicant's specification is drawn completely to automobile

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insignia. There is no suggestion in the specification that Applicant's filler is intended as anything other than as used with an automobile insignia.

5. Claims 1-5 and 7-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is unclear as to what is disposed on a surface as required by the limitations of the claim. Is it the filler or the insignia? To further prosecution, claim 1 has been interpreted as a filler (a decorative type material) for decorating an insignia wherein the filler is adapted to (ie: through cutting and fitting either during production or after purchase by the end user) fill the open spaces of the insignia on a surface.

Claims 2-5 and 7-14 are also rejected for either directly or indirectly depending from claim 1.

Claim Objections

1. Claim 7 is objected to because of the following informalities:

Claim 7, line 3 has the limitation "a magnet for attracting an automobile" should that read "a magnet for attaching to an automobile"? Clarification is needed for claim 7.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-2 and 13-14 are rejected under 35 U.S.C. 102(b) as being anticipated by United States Patent no. 4,139,654, Reed.

Regarding claims 1 and 13-14

Reed discloses a medallion like article (insignia), a hexagonally shaped article having a substrate with a central opening. A medallion may be formed as a unitary part of the product upon which it is to appear. A decorative design can be cast directly into the body of the appliance wherein the polymer (filler) is deposited directly upon the decorative design. The body part is acting as the substrate of the decorative design, (Figure 2, columns 5-6, lines 60-10). Furthermore, as the presently claimed features relate only to ornamentation with no mechanical function whatsoever, the claimed features are not patentably distinct over the prior art of record. *See In re Seid*, 161 F.2d 229, 231, 73 USPQ 431,433 (CCPA 1947), meeting the limitations of claims 1 and 13-14.

Regarding claim 2

Coloring dyes can be used in the polymer layer, (column 6, lines 37-45), meeting the limitations of claim 2.

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7. Claims 1-2 and 13-14 are rejected under 35 U.S.C. 102(b) as being anticipated by United States Patent no. 4,712,314, Sigoloff.

Regarding claim 1

Sigoloff discloses a footwear sole (insignia) having a recess portion in the sole with a decorative insert assembly (filler) placed into the recess portion, (column 1, lines 5-10 and column 2, lines 51-65). Furthermore, as the presently claimed features relate only to ornamentation with no mechanical function whatsoever, the claimed features are not patentably distinct over the prior art of record. *See In re Seid*, 161 F.2d 229, 231, 73 USPQ 431,433 (CCPA 1947), meeting the limitations of claims 1 and 13-14.

Regarding claim 2

The insert is comprised of a flexible plastic material a decorative paper element bearing the picture or text, which is taken to mean that the picture or text has some color whether that color is black and white or another color, (columns 2-3, lines 61-9), meeting the limitations of claim 2.

8. Claims 1-2, 4, and 13-14 are rejected under 35 U.S.C. 102(b) as being anticipated by United States Patent no. 4,830,892, Nussbaum.

Regarding claims 1 and 13-14

Nussbaum discloses a molding placed on the side of a car with an area cut out of the molding and a decorative insert (insignia) placed within the molding in contact with the surface of the automobile. An overlay (filler) fully covers the insert that extends to the surface of the automobile, (Figure 5, columns 2-3, lines 33-15), meeting the limitations of claims 1 and 13-14.

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Regarding claim 2

The overlay can be polyvinylchloride and tinted, (column 2, lines 62-64), meeting the limitations of claims 2 and 4.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 1-2 and 7-14 are rejected under 35 U.S.C. 103(a) as obvious over United States Patent no. 5,549,940, Noone in view of United States Patent no. 5,939,155, Voznick et al.

Regarding claim 1

Noone discloses a sports theme kit for outfitting an automobile that includes signs that can be temporarily affixed to the vehicle through the use of magnets. The signs are made of a

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flexible magnetic sheet. On vehicles parts that magnets would not adhere, the backing should have an adhesive material, (column 5, lines 28-33). A roll of flexible tape is decorated with the team's colors that can be trimmed to the desired length and attached to a vehicle's surface, (column 5, lines 4-16). Hubcap decals can also be trimmed to size by the consumer, (column 5, lines 17-26). Noone et al do not specifically disclose that the decorative tape is used as a filler for an insignia.

The essential concept of the Noone et al invention is to decorate any available surface of a vehicle with team colors. Because the flexible decorated tape can be trimmed to the desired length and attached to the vehicle, it would have been obvious to one skilled in the art at the time of invention to determine where on the vehicle the decorative tape should be placed to provide the desired decorative effect.

Regarding claims 2, 7, 11, and 13

The roll of flexible decorative tape is decorated with team colors wherein the tape can be made of magnetic material or a plastic sheet with an adhesive material on the backside, claims 2 and 11. A roll of flexible tape can be trimmed to the desired length and attached to a vehicle's surface through the use of magnets, (column 5, lines 4-16), claims 7 and 13.

Regarding claim 8

As the decorative tape is flexible, it is assumed to be rubberized absent a showing to the contrary, claim 8.

Regarding claims 9-10 and 12

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The limitations of claims 1-2 and 7 have been set forth above. The decorative tape can be attached through a magnetic backing or through the use of permanent adhesive backings, (column 2, lines 59-64). Noone does not specifically disclose that the decorative tape is attached to the vehicle through the use an adhesive underlying the magnetic strip or the use of double-sided tape.

Voznick et al disclose a decorative cap attached to the surface of an automobile through a magnetic base. The magnetic base is comprised of a magnetic base bottom that includes a two-sided adhesive layer, (column 2, lines 45-67).

Noone and Voznick et al disclose analogous inventions related to the decoration of automobile surfaces. It would have been obvious to one skilled in the art at the time of invention to modify the magnetic substrate of Noone with the double sided adhesive layer of Voznick et al in order to provided additional support for the decorative layer, (Voznick, column 2, lines 59-63), claims 9-10 and 12.

Regarding claim 14

The use of the filler as a filler for an automobile insignia does not provide a patentable distinction over the prior art of record as a filler for an automobile insignia does not change the functionality of the decorative materials as set forth in Noone as the presently claimed features relate only to ornamentation with no mechanical function whatsoever, the claimed features are not patentably distinct over the prior art of record. *See In re Seid*, 161 F.2d 229, 231, 73 USPQ 431,433 (CCPA 1947), claim 14.

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Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gwendolyn Blackwell whose telephone number is (571) 272-1533. The examiner can normally be reached on Monday - Thursday; 6:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer McNeil can be reached on (571) 272-1540. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gwendolyn Blackwell
Examiner
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JENNIFER C. MCNEIL
SUPERVISORY PATENT EXAMINER
4/8/06